

### **Remarks/Arguments**

In the Office Action, the Examiner rejected claims 1-9 and 19-23 under 35 U.S.C. § 103(a) as being unpatentable over WO 02/07902 (WO '902) in view of Huvar, U.S. Patent No. 4,349,392 (Huvar). The Examiner also rejected claims 1-9 and 19-23 under 35 U.S.C. 103(a) as being unpatentable over Oshima et al. U.S. 6,719,852 (Oshima) in view of WO '902.

The element of Claim 7, "wherein the organic chelate is present in a concentration of from about 0.02M to about 0.3M", is incorporated in Claims 1, 19, and 20.

Claim 7 is cancelled.

Claims 1-6, 8-9 and 19-23 are pending.

Applicant summarizes the Examiner's rejections as shown below:

Rejection #	Primary reference disclosing elements except:	Secondary reference disclosing:	TSM-based Combination
1	WO '902: Chelate concentration and Nitrate ion concentration	Huvar: Chelate concentration	WO'092+Huvar
2	Oshima: Black coating	WO'092: Black coating	Oshima+WO'092

### **Rejection #1 Should Be Withdrawn**

The Examiner states that the motivation for WO'092+Huvar combination is that the chelates (carboxylic acids) in Huvar improve initial hardness to the chromate film.

Applicants respectfully submit that the Examiner is factually in error. Applicants presume that the examiner actually meant that the motivation for WO'092+Huvar combination is that the chelates (carboxylic acids) in Huvar improve not only the initial hardness, but also the clarity of the film. (Please see Lines 1-25, Column 6 in Huvar)

Applicants make the following argument based on this presumption.

Applicants respectfully submit that the motivation does not exist because the motivation is self-conflicting. According to the Examiner, the motivation must be that a skilled artisan wants to make a black chromate coating with good hardness and clarity. To make a black chromate coating, the skilled artisan would consult WO'092 and, then seek help to improve the hardness and clarity, perhaps identifying Huvar to serve his goal.

However, the skilled artisan would quickly determine that he cannot simultaneously achieve all three goals, i.e. the black coating, hardness, and clarity, since blackness and clarity are not mutually-compatible. For example, by clarity Huvar means that the film is not "cloudy" and exhibits "optimum clarity from an appearance standpoint". (Please see Lines 47-51, Column 1) Huvar's films "range from a clear bright to a light blue-bright to a yellow iridescent appearance", none of which is **BLACK**. (Please see Lines 55-60, Column 1) Huvar further teaches that "the unexpected improvement in clarity of the film is particularly pronounced in connection with the light-yellow iridescent films (**NOT BLACK**) produced from cerium ion containing solutions". Furthermore, the Examiner states that WO '902 also does not explicitly teach the claimed sulfate and/or nitrate ion concentrations. (Please see Lines 1-25, Column 6 in Huvar).

However, the Examiner makes no comment on what the motivation is for WO'092+Huvar combination to teach the presently claimed nitrate ion concentration. Applicants have carefully reviewed the prior art documents, and did not find any motivation that teaches the claimed sulfate ion concentration.

Accordingly, there is no motivation and Rejection #1 should be withdrawn.

### **Rejection #2 Should Be Withdrawn**

The Examiner states that WO'092 teaches how to make a black coating; and if Oshima is modified with WO'092, Oshima would and could give a black coating too.

The Examiner further states that a black coating is made according to WO'092 by controlling the cobalt concentration "between 0.001 mol/l and 0.1 mol/l (i.e. 0.059-5.9g/l)".

If Oshima also uses this cobalt concentration range, Oshima would also produce a black coating.

Oshima has actually tested the Examiner's theory.

Oshima's experimental data clearly disputes the Examiner's allegation. Examples 1 and 2 in Oshima use 0.2g/l and 0.5g/l  $\text{Co}^{2+}$ , which are both within the 0.059-5.9g/l range. However, Table 4 in Oshima clearly indicates that both the films of Examples 1 and 2 have a pale blue appearance.

As such, there is no motivation to combine Oshima and WO'092 or a basis to conclude that the presently claimed invention would be achieved. Therefore, Rejection #2 should be withdrawn.

## CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-6, 8-9 and 19-23) are now in condition for allowance.


Respectfully submitted,

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Date



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